

## **REMARKS**

### **I. Summary Of Office Action**

Claims 20-34 were pending in the application.

Claims 20-34 were rejected under 35 U.S.C. § 112, second paragraph.

Claims 20-34 were rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent number 6,970,837 (“Walker”) in view of United States Patent number 5,664,110 (“Green”).

### **II. The Rejection of the Claims Under 35 U.S.C. § 112, Second Paragraph**

The Office Action rejected claims 20-34 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Specifically, the Office Action referencing the claim element “if at least one product substitute is found in the product database, adding the at least one product substitute to the substitute table and sending the customer a recommendation of the at least one product substitute,” states that “[i]t is unclear from this limitation how a substitute product could be a substitute product without being in the substitute table.” (Office Action, p. 2).

Applicant respectfully submits that the language of claim 20 is clear and satisfies the requirements of 35 U.S.C. § 112, second paragraph. Claim 20 recites, among other things:

(f) determining whether said first product is available by querying said product database;

(g) if it is determined that said first product is not available by querying said product database, determining whether a substitute product is indicated in a substitute table;

(h) if said first product is determined not to have a substitute indicated in the substitute table, searching for at least one product substitute in the product database by comparing attributes of the first product to attributes of products in the product database;

(i) if at least one product substitute is found in the product database, adding the at least one product substitute to the substitute table and sending the customer a recommendation of the at least one product substitute.

As quoted above, claim 20 recites at least two ways that a substitute product can be found. The first is by “determining whether a substitute product is indicated in a substitute table.” The second is “searching for at least one product substitute in the product database by comparing attributes of the first product to attributes of products in the product database,” which

is performed “if said first product is determined not to have a substitute in the substitute table” as recited in claim 20.

Thus, in response to the Office Action statement that “[i]t is unclear from this limitation how a substitute product could be a substitute product without being in the substitute table,” (Office Action, p. 2), a substitute product can be a substitute product without being in the substitute table, and such a product can be found, for example, by “searching for at least one product substitute in the product database by comparing attributes of the first product to attributes of products in the product database,” as recited in claim 20.

Independent claims 25 and 30 were rejected on the same or similar grounds. Each of claims 21-24, 26-29, and 31-34 depends from one of claims 20, 25, and 30 and was rejected based on their dependence from a rejected base claim. Accordingly, Applicant respectfully submits that claims 20-34 are definite and that they particularly point out and distinctly claim the subject matter sought to be defined by these claims. Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 112.

### **III. The Rejection of Claim 20 Under 35 U.S.C. § 103(a)**

Claims 20-34 were rejected under 35 U.S.C. §103(a) as being unpatentable over Walker in view of Green. Claim 20 defines a method that recites, among other things:

(f) determining whether said first product is available by querying said product database;

(g) if it is determined that said first product is not available by querying said product database, determining whether a substitute product is indicated in a substitute table;

(h) if said first product is determined not to have a substitute indicated in the substitute table, searching for at least one product substitute in the product database by comparing attributes of the first product to attributes of products in the product database;

(i) if at least one product substitute is found in the product database, adding the at least one product substitute to the substitute table and sending the customer a recommendation of the at least one product substitute.

In reference, to Applicant’s above comments regarding 35 U.S.C. § 112, second paragraph and in response to the Office Action statements regarding the same, Applicant respectfully submits that claim 20 does not merely recite “if a product substitute exists, sending the customer a recommendation of the product substitute.” (Office Action, p. 3). Instead,

Applicant respectfully submits that claim 20 should be interpreted to include all limitations and respectfully requests that the Examiner reconsider the claim to include the limitation not considered, namely, “if said first product is determined not to have a substitute indicated in the substitute table, searching for at least one product substitute in the product database by comparing attributes of the first product to attributes of products in the product database”.

Walker merely describes a system that includes a retailer determining substitute products based on various considerations and offering such products to a consumer. In contrast, nothing in Walker, alone or in combination with Green, teaches or suggests, for example, searching a product database for a substitute product contingent on not finding a substitute product in a substitute table, let alone “determining whether said first product is available by querying said product database; if it is determined that said first product is not available by querying said product database, determining whether a substitute product is indicated in a substitute table; if said first product is determined not to have a substitute indicated in the substitute table, searching for at least one product substitute in the product database by comparing attributes of the first product to attributes of products in the product database; [and] if at least one product substitute is found in the product database, adding the at least one product substitute to the substitute table and sending the customer a recommendation of the at least one product substitute,” as recited in claim 20.

Green, which describes a remote ordering system that describes building and editing ordered lists, does not remedy the above discussed deficiencies of Walker, nor does the Officer Action assert that it does.

Accordingly, Applicant respectfully submits that claim 20 is allowable and respectfully requests the withdrawal of the rejection to the same.

Each of independent claim 25 and claim 30 recite similar limitations to independent claim 20 and is allowable for at least the reasons provided with respect to claim 20. Claims 21-24, 26-29, and 31-34 each depend from one of claims 20, 25, and 30 and are thus allowable for at least the same reasons as the claim from which they depend are allowable. Accordingly, Applicant submits that claims 21-34 are also allowable and respectfully requests the withdrawal of the rejection to the same.

### **CONCLUSION AND AUTHORIZATION**

Applicant respectfully submits that, as described above, the cited references do not show or suggest the combination of features recited in the claims. Applicant strongly emphasizes that one reviewing the prosecution history should not interpret any of the examples Applicant has described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, Applicant asserts that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicant has emphasized certain features in the claims as clearly not present in the cited references, as discussed above. However, Applicant does not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, Applicant has provided examples of why the claims are distinguishable over the cited prior art.

The Commissioner is hereby authorized to charge any additional fees, which may be required for this Amendment, or credit any overpayment, to Deposit Account No. 08-0219

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 08-0219.

Respectfully submitted,

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